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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,110	07/15/2003	Shigeru Hosoe	02860.0747	5811

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EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,110

Applicant(s)

HOSOE ET AL.

Examiner

Mark A. Deuble

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-31 and 43-49 is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-22 and 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14, 17-22 and 32-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 18, and 32 recite an apparatus and a method of using that apparatus which renders the scope of the claims indefinite. Specifically, the claim preambles are directed to a load conveyance device and the bodies of the claim recite both the structure of the device and a method of using the device in a wherein clause and thus the scope of the invention is unclear because a claim may be directed to only one statutory class of invention. See IPXL HOLDINGS. V. Amazon.com, 430 F.3d 1377, 1384 (Fed. Cir. 2005). In this case, decided on November 17, 2005, the court citing to Ex Parte Lyell, 17 USPQ 1548 (BPAI 1990), stated as follows:

“the statutory class of invention is important in determining patentability and infringement.” *Id.* at 1550 (citing *In re Kuehl*, 475 F.2d 658, 665 [177 USPQ 250] (CCPA 1973); *Rubber Co. v. Goodyear*, 76 U.S. 788, 796 (1870)). The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of

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using the apparatus. *Id.* Thus, such a claim “is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved” and is “ambiguous and properly rejected” under section 112, paragraph 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 10-14, and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimoto et al. (U.S. Patent No. 6,370,915).

Fujimoto et al. shows in Figures 18 and 20 a load conveying device comprising a plurality of glass load supporting devices 15, each having a through hole passing therethrough in a gravity direction arranged so that each hole aligns in series (or parallel depending on the direction from which the load is supplied to the device), and a fluid supplying device (not shown, but see col. 11, ln. 23-45) that supplies a fluid such as nitrogen into the through hole in varying amounts depending on the weight of the load supplied to the device. This allows a load dropped into the through hole from a top of the through hole to be supported under a floating condition by a force of the fluid in the through hole until the force of the fluid is changed and a shutter 14 is opened to allow the load to drop from a lower end of the through hole to an outside. The top section of the through hole has a tapered wall section whose inside diameter increases toward a

top open end so that the tapered wall section forms an angle between 0° and 90° with the lower portion of the through hole. Furthermore, because it is preferable to have the corners of the funnel shape rounded to guide material smoothly (col. 6, ln. 15-20), the rounded upper edge of the device 15 would form a tapered end section having a taper angle greater than that of the tapered well section below it. As can be seen in Fig. 20, the height of the tapered wall section is slightly larger than the height of the load so that it is between 0.2 times and 2.0 times the height of the load. A heating device 13 adjacent the device 15 raises the temperature of the load and the fluid around it to much higher than room temperature so that the load is conveyed and heated in a fused condition close to its glass transition temperature. The load as illustrated appears to be spherical with no deviation and if the load is a glass gob with an irregular shape, such surface defects may be eliminated during the heating and floating operation of the device so that a deviation from spherical of the load in either case is half of less than the average radius of the load. Thus, Fujimoto et al. shows all the structure required by claims 1-5, 10-14, and 17-22.

In regard to the clause in independent claims 1 and 18, stating "wherein a load is dropped into the through hole ... the load drops from a lower end of the through hole to an outside." It should be noted that the preamble of these claims direct them to a load conveyance device and not to a method of using a load conveyance device. Therefore, the device must have some structure that differentiates it from the prior art and not a different method of use to be patentable.

Allowable Subject Matter

5. Claims 23-31 and 43-49 are allowed.
6. Claims 32-42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
7. Claims 6-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (571) 272-6912. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md

MARK A. DEUBLE
PATENT EXAMINER
Mark A. Deuble